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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,682	06/28/2006	Kunikazu Tauchi	284679US0PCT	2610

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

POURBOHLOUL, SARIRA CAMILLA

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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11/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/565,682	Applicant(s) TAUCHI ET AL.	
	Examiner S. CAMILLA POURBOHLOUL	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/9/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/24/2006, 4/24/2006, 8/14/2009.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-2 in the reply filed on August 17, 2009 is acknowledged. Claims of group I and group II are drawn to an alkali-soluble silicon-containing polymer and to the process of making it and thus lack unity of invention and inflict burden on examiner by having to search in two distinct classes of 528 and 427. Specifically the specific process steps claimed in group II are not required for the examination of group I.

Claims of group I and group III are drawn to two different alkali-soluble silicon-containing polymers which lack unity of invention *a priori*.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-7 of group II and III are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

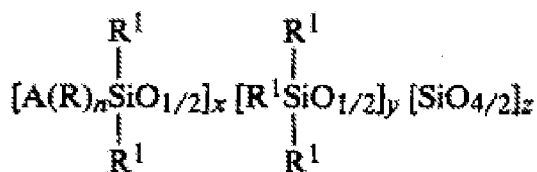
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirahata et al. (US 4,946,921) in view of Hirayama et al. (US 2006/0003252).

Shirahata et al. teaches an alkali-soluble organosiloxane with the general formula of:



where A is a hydroxyphenyl group; R is an alkylene group having 1 to 4 carbon atoms; n is zero or one; R¹ is an alkyl group having 1 to 4 carbon atoms; x, y, and z have values such that their ratios are 0.3≤(x=y)/z≤4; and 0≤y/x≤5 (col. 1, lines 39-54) and a molecular weight from 500 to 500,000 (col. 2, lines 18-20). Shirahata teaches the hydroxyphenyl containing siloxane to be a monofunctional unit (M unit) rather than a trifunctional unit (T unit). Hence attention is directed to the positive-working resist composition of Hirayama et al., where, the silicone composition comprises an alkali soluble resin (A) and a photoacid generator (B) [0013-0016]. Furthermore, compound (A) comprises a (hydroxyphenylalkyl) silsesquioxane unit (a₁) and phenylsilsesquioxane unit (a₃). The silicon-containing polymer composition of Shirahata is solid at room temperature (col. 2, lines 16-17 and claim 2).

Hirayama teaches the phenyl alkyl silsesquioxane of its invention is employed as a resist material for engraving a pattern in the substrate by plasma etching with a mask pattern-formed of the positive-working resist layer as the upper layer [0005]. This trifunctional siloxane not only imparts alkali-solubility to the composition but it also makes the composition etching resistant for engraving a pattern in the substrate even with a small thickness [0006]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the (hydroxyphenylalkyl) silsesquioxane unit of Hirayama to the alkali-soluble organosiloxane composition of Shirahata for the benefit of making a high resistant, alkali-soluble composition for use in microprocesses in LSI device fabrication (col. 4, line 4-7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. CAMILLA POURBOHLOUL whose telephone number is (571)270-7744. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

/SCP/